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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sherwin-Williams Automotive Finishes Corp.

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Serial No. 78322049

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Arthi K. Tirey of Sherwin-Williams Company Legal Dept. for  
Sherwin-Williams Automotive Finishes Corp.

Ann Sappenfield, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

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Before Hohein, Drost, and Kuhlke, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 3, 2003, Sherwin-Williams Automotive  
Finishes Corp. (applicant) filed an intent-to-use  
application (Serial No. 78322049) to register the mark  
SQUEEGEE PRIME on the Principal Register for "protective  
and decorative coatings in the nature of paint, namely  
automotive primers" in Class 2. The examining attorney  
refused registration on the ground that the mark was merely

descriptive of the goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). On February 16, 2004, applicant filed an Amendment to Allege Use that set out February 5, 2004 as the dates of first use. We also note, however, that the mark in the USPTO's electronic records is identified as "An illustration with word(s)/letter(s)/number(s) in stylized form." The mark in the USPTO's electronic database is set out below:

SQUEEGEE PRIME

The mark on the specimen is shown in a very simple style:



Therefore, to the extent that the mark is not in standard character form, the stylization is not a significant factor in determining whether the mark as a whole is merely descriptive because it would not be stylized enough to permit the registration of the term with a disclaimer of the words.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D.

Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920).

See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980).

"Such qualities or properties include color, odor, function, dimensions, or ingredients." In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987) (internal quotation marks omitted). It is important to keep in mind that the question of descriptiveness is not determined in the abstract. For example, in this case we do not simply consider whether the term SQUEEGEE PRIME means anything to people. Instead, we must consider whether that term, when used in association with automotive primers, would immediately describe a feature or characteristic of those primers to prospective purchasers of those goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, we must consider whether the mark in its entirety is merely descriptive. P.D. Beckwith, Inc., 252 U.S. at 545-46.

We now look at the record to determine if applicant's mark is merely descriptive. "The perception of the relevant purchasing public sets the standard for determining descriptiveness. Any competent source suffices to show the relevant purchasing public's understanding of a

contested term or phrase." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (citation omitted).

The examining attorney points (brief at unnumbered p. 3) to a definition of "squeegee" to mean "a device that consists of a handle and a transverse piece at one end set with a blade of leather or rubber and is used for spreading or wiping liquid material on, across, or off a surface (as a pavement, windowpane, or deck)." *Webster's Third World International Dictionary* (1993).<sup>1</sup> The examining attorney also included printouts from the Internet. The first reports that applicant's "Squeegee Prime" is "[a]vailable for use in two different application techniques (sprayable and spreadable)." www.collision-insight.com. The second webpage, from applicant's website, is an order form for SQUEEGEE PRIME. Under the heading "Associated Product," the first two items are:

3M05517	CS	3M Wetordry Rubber Squeegee, 2-3/4" x 4-1/4", Case of 50
3M05518	CS	3M Wetordry Rubber Squeegee, 3" x 2", Case of 50

This webpage shows that applicant itself distributes squeegees as an associated product for use with its

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<sup>1</sup> Although not previously made of record, we take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

SQUEEGEE PRIME automotive primers. Furthermore, applicant has responded to the examining attorney's request for information by stating that "the primer can be applied with a squeegee." Response dated November 22, 2004 at 7.

Therefore, the evidence demonstrates that applicant's goods include a spreadable primer that is designed to be applied with a squeegee.

Regarding the term "prime," we note that the goods are identified as "automotive primers." Applicant's specimen and order form refer to the goods as "primer." The verb "prime" is defined as "to prepare (a surface) for painting by covering with size, primer, or an undercoat." *The American Heritage Student Dictionary* (1988).<sup>2</sup> Therefore, applicant's primer would be used to "prime" the surfaces of automobiles.

Despite the fact that the individual terms are both descriptive of applicant's goods, the next question becomes whether the mark as a whole is merely descriptive. The examining attorney maintains that there is no alternative meaning for the mark and that "the mark still refers to the purpose or feature of the goods, and nothing more." Brief

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<sup>2</sup> We also take judicial notice of this dictionary definition.

at unnumbered p. 6. Applicant, on the other hand, argues (Brief at 6-7) that:

The mark SQUEEGEE PRIME, on the contrary, does not describe any real or specific item or characteristic or quality, and therefore is not merely descriptive in connection with Applicant's goods. The consumer who is interested in obtaining paints and coatings would first have to conclude that the combined terms "SQUEEGEE" and "PRIME" refer to a coating product.

Not only are Applicant's goods ... not a "squeegee," but the term "prime" has numerous meanings... Therefore, since different interpretations are possible for the mark "SQUEEGEE PRIME," at least a short leap of the imagination would be required to grasp [the] particular ... nature of Applicant's product. The resulting composite word of the combination of "squeegee" and "prime" has an incongruous meaning that is not descriptive.

As indicated initially, we must determine the issue of descriptiveness in the context of the goods or services with which the mark is used. Therefore, inasmuch as our starting point in this case is the use of the mark on automotive primers, prospective purchasers would not have to conclude that the mark is referring to a coating product as applicant suggests. Also, while the term "prime" can have numerous meanings, in relation to automotive primers the term "prime" would clearly refer to the process of priming the vehicle. Finally, we see nothing incongruous about the use of the term SQUEEGEE PRIME in relation to a spreadable automotive primer that is applied with a squeegee. Instead, the term immediately and exactly

describes a feature or characteristic of the product, i.e., a squeegee is used in the process of priming the automobile. Competitors should similarly be able to describe their spreadable primers that are used to prime vehicles with a squeegee by the term SQUEEGEE PRIME. Therefore, we conclude that the mark as a whole is merely descriptive.

Decision: The examining attorney's refusal to register on the ground that applicant's mark when used on its goods is merely descriptive is affirmed.